

Amendment and Response Under 37 C.F.R. §1.116 - Expedited Examining Procedure Page 29 of 33
Serial No.: 10/672,814
Confirmation No.: 8914
Filed: 26 September 2003
For: DENTAL COMPOSITIONS AND METHODS WITH ARYLSULFINATE SALTS

Remarks

The Office Action mailed 14 November 2006 has been received and reviewed. The pending claims are claims 1-73.

Claims 18-62 and 67-73 having been withdrawn from consideration by the Examiner as being directed to a non-elected group, the claims currently under consideration are claims 1-17 and 63-66.

Independent withdrawn claims 18, 21, 25, 29, 34, 44, 55, and 67-73 have been cosmetically amended to include all the language of one or more of the claims currently under consideration as noted herein below under a further request for rejoinder.

Reconsideration and withdrawal of the rejections are respectfully requested.

Obviousness-Type Double Patenting Rejections

Claims 1-17 and 63-66 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 7,030,169. Applicants respectfully traverse the rejection.

Attached herewith as EXHIBIT A is a copy of a terminal disclaimer with respect to the present application that is dated 23 September 2005 and was submitted for U.S. Application Serial No. 10/672,762, now U.S. Patent No. 7,030,169. Applicants respectfully submit that the terminal disclaimer is in compliance with 37 CFR 1.321(c), and thereby obviates the Examiner's double patenting rejection of claims 1-17 and 63-66.

Claims 1-17 and 63-66 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 7,064,152. Applicants respectfully traverse the rejection.

Attached herewith as EXHIBIT B is a copy of a terminal disclaimer with respect to the present application that is dated 5 January 2006 and was submitted for U.S. Application Serial No. 10/847,523, now U.S. Patent No. 7,064,152. Applicants respectfully submit that the

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terminal disclaimer is in compliance with 37 CFR 1.321(c), and thereby obviates the Examiner's double patenting rejection of claims 1-17 and 63-66.

Reconsideration and withdrawal of the obviousness-type double patenting rejections are respectfully requested.

Provisional Obviousness-Type Double Patenting Rejections

Claims 1-17 and 63-66 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of copending Application No. 10/847,523. Applicants respectfully traverse this rejection.

Because Application No. 10/847,523 issued as U.S. Patent No. 7,064,152 on 20 June 2006 and thus, is no longer pending, the provisional obviousness-type double patenting rejection is moot. Further, the obviousness-type double patenting rejection over U.S. Patent No. 7,064,152 has been addressed in the remarks herein above.

Claims 1-17 and 63-66 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of copending Application No. 11/275,830. Applicants respectfully traverse the rejection.

"If a 'provisional' nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer." M.P.E.P. §804(I)(B)(1).

Because the provisional obviousness-type double patenting rejection is the only rejection remaining in the present application, which is the earlier filed of the two pending applications, Applicants respectfully request that the Examiner withdraw the rejection and permit the present application to issue as a patent without a terminal disclaimer pursuant to M.P.E.P. §804(I)(B)(1).

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Reconsideration and withdrawal of the provisional obviousness-type double patenting rejections are respectfully requested.

Request for Rejoinder

Applicants requested rejoinder of withdrawn claims 18-62 and 67-73 on pages 34-35 of the Amendment and Response submitted 16 October 2006. The Examiner acknowledged Applicants' request, but indicated that rejoinder was not proper under *In re Ochiai* (page 4 of the Office Action mailed 14 November 2006). Applicants respectfully disagree and again request that the Examiner reconsider and rejoin withdrawn claims 18-62 and 67-73 for at least the reasons recited in the Amendment and Response submitted 16 October 2006, which are incorporated herein by reference. Further, Applicants respectfully submit that rejoinder is not discretionary, but is required by the rules.

"[I]f applicant elects a claim(s) directed to a product which is subsequently found allowable, withdrawn process claims which depend from or otherwise require all the limitations of an allowable product claim *will be considered for rejoinder*. All claims directed to a nonelected process invention must depend from or otherwise require all the limitations of an allowable product claim for that process invention to be rejoined." M.P.E.P. §821.04(b) (emphasis added).

Withdrawn claims 18-24 (as amended) are process claims that require all the limitations of, for example, independent product claim 1. Withdrawn claims 25, 27-29, and 31-33 (as amended) are process claims that require all the limitations of, for example, independent product claim 12. Withdrawn claims 26 and 30 are process claims that require all the limitations of, for example, both independent product claims 1 and 12. Withdrawn claims 67 and 68 (as amended) are process claims that require all the limitations of, for example, independent product claim 65. Withdrawn claims 69 and 70 (as amended) are process claims that require all the limitations of, for example, independent product claim 66. Because independent claims 1, 12, 65, and 66

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should all now be in condition for allowance, Applicants respectfully request that claims 18-33 and 67-70 be rejoined, examined, and passed on to allowance pursuant to M.P.E.P. §821.04(b).

"Where restriction was required between independent or distinct products, or between independent or distinct processes, and all claims directed to an elected invention are allowable, any restriction requirement between the elected invention and any nonelected invention that depends from or otherwise requires all the limitations of an allowable claim should be withdrawn. For example, a requirement for restriction should be withdrawn when a generic claim, linking claim, or subcombination claim is allowable and any previously withdrawn claim depends from or otherwise requires all the limitations thereof. Claims that require all the limitations of an allowable claim *will be rejoined* and fully examined for patentability in accordance with 37 CFR 1.104." M.P.E.P. §821.04(a) (emphasis added).

Withdrawn claims 34-62 (as amended) are product claims that require all the limitations of, for example, independent product claim 12. Withdrawn claims 71-73 (as amended) are product claims that require all the limitations of, for example, independent product claim 66. Thus, claims 12 and 66 are linking claims to withdrawn claims 34-62 and 71-73, respectively. Because independent claims 12 and 66 should both now be in condition for allowance, Applicants respectfully request that claims 34-62 and 71-73 be rejoined, examined, and passed on to allowance pursuant to M.P.E.P. §821.04(a).

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Summary

It is respectfully submitted that all the pending claims are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted

By

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January 15, 2007

Date

By: [Signature]

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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that the Transmittal Letter and the paper(s), as described hereinabove, are being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 15th day of January, 2007, at 10:45 am (Central Time).

By: [Signature]

Name: Sue Dombroske